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09/919,204	07/31/2001	Hideyuki Aoki	FUJH 18.876	3969
26304      7590      05/01/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
LIN, WEN TAI				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/919,204

## Applicant(s)

AOKI ET AL.

## Examiner

Wen-Tai Lin

## Art Unit

2154

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 5-15, 18 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) 23, 27 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 5-15, 18, 21-22, 24-26, 28-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1, 5-15, 18 and 21-31 are presented for examination. Claims 21 and 31 are newly added.

### ***Restriction***

2. Restriction to one of the invention is required under 35 U.S.C. 121 because the invention contains two different species, which are independent or distinct because:

I. Claims 1, 5-15, 18, 21-22, 24-26, 28-29 and 31, drawn to content distribution over a network, classified in class 709, subclass 217.

II. Claims 23, 27 and 30, drawn to presentation processing of documents or annotation control, classified in class 715, subclass 200 or 230.

3. Since claims 23, 27 and 30 are added by amendment following action by the examiner, Applicant is required to restrict the claims to the invention previously claimed (see 37 CFR 1.145 and MPEP 818.01 and 818.02(a)).

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

8. Claims 24, 28 and 31 are objected to because the term “the access information” lacks antecedence basis.

9. In the previous office action Applicant was requested to clarify what type of IP addresses (permanent or temporary) were used for communicating/distributing information to each of the terminal devices, as required by the amended independent claims. In response, Applicant made no direct answer to the examiner’s question, but stated that “IP address may include a MAC address, which can identify a terminal on a

network using the IP protocol.” Applicant then cited paragraphs 73 and 77 of the published application for a reference to IP addresses.

Applicant is reminded that in accordance with the conventional Internet Protocol, there is no field reserved for MAC address in an IP header (see, for example, RFC 791). While MAC address is typically used for terminal addresses in a local area network (such as Ethernet), it solely relies on a gateway server to map IP address of an inbound packet to a corresponding MAC address for the destination terminal. Furthermore, it is noted that Applicant’s specification makes no description about the MAC address. Paragraph 73 only mentions about the IP address or URL of a management server. Paragraph 77 states that either a telephone number or IP address may be used as a transmission destination terminal for shared information. Since the transmission destination is entered as a terminal registration information (see Figs. 2A-2B), it appears that Applicant’s invention requires that the terminal information be re-registered (with the management server) every time a terminal of the intended information sharing group changes its IP address unless a telephone number is used as the transmission destination.

Applicant is noted that by admitting this inherent requirement, the previous objection on claims 1-20 would be withdrawn.

### ***Claim Rejections - 35 USC § 102***

10. Claims 1, 11, 15, 18, 21-22, 24-26, 28-29 and 31 are rejected under 35 USC 102(e) as being anticipated by Kawashima et al. [US PGPub 20050239454].

11. As claim 1, Kawashima teaches the invention as claimed including an information distribution device [ASP, Fig.3A] which is connected with a plurality of terminal devices [e.g., terminals A-C, Fig.3A] which belong to a group, and a content server storing distribution information via a network using an IP protocol, said information distribution device, comprising:

a first storage portion storing terminal information including addresses each identifying a terminal device belonging to said group, on the network using IP protocol [e.g., 13-14, Fig.1; paragraph 13];

a first receiving portion receiving, from one terminal device [e.g., terminal A, Fig. 3A] belonging to said group, a distribution request including a Uniform Resource Location as access information [typically an ASP has a URL for users to communication a request] and distribution destination information, said access information being required for accessing the distribution information stored in the content server, said distribution destination information specifying addresses on the network of other terminal devices that the one terminal device which belong to said group and to which the distribution information is to be distributed [Fig. 3A; paragraphs 87 and 145-146];

a second receiving portion accessing said distribution information stored in a content server, based on said access information included in the distribution request received by said first receiving portion from the one terminal device, and for receiving the distribution information accessed [e.g., content provider, Fig.3A];

a second storage portion storing said distribution information accessed and received by said second receiving portion [i.e., there must be a storage in the ASP storing the downloaded content from the content provider];

a first transmitting portion transmitting said distribution information stored in said second storage portion to the other terminal devices [Fig.3A; paragraph 146; note that the ASP calls the terminals B and C for download of the contents];

a third receiving portion receiving a bill of charges from a device billing charges for the distribution information when the distribution information is chargeable [Fig.3B; note that the ASP is charged for contents rate from the content provider]; and

a second transmitting portion transmitting said bill of charges received by said third receiving portion either to the one terminal device having transmitted the distribution request or to a telecommunications carrier to which the one terminal device subscribes [e.g., Fig. 3B; bill for contents share service rate is sent to terminal A from the ASP].

12. As to claims 11, 15, 18, 21, 24-25, 28-29 and 31, since all the features in these claims can also be found in claim 1, they are rejected for the same reasons set forth in the rejection of claim 1 above.

As for the additional limitations in claims 21, 25 and 29 requiring using access destination information (e.g., source address of the requesting user) to access to the content server (provider): it is noted that Kawashima's distribution of content is based on the fact the users must hold a license with the content provider [e.g., see Abstract and Fig. 2A]. As such, it is clear that the ASP must present the user's ID (or destination information) in order to access to the provider's content.

As for the additional limitations in claims 24, 28 and 31 requiring the access information to identify the content server and indicates data location in the content

server: it is noted that this is an inherent feature in Kawashima's system because without information about which provider hold the content and where the content is located in the provider, the ASP of Kawashima's system won't be able to serve the requested data [note that it is well known that a provider's content database is organized with keys that specific content can be retrieved by specifying the name of a content which a user provides in the request].

13. As to claims 22 and 26, Kawashima teaches that the method further comprising storing the information in a storing unit and deleting the stored information after completion of the information distribution [e.g., paragraph 306].

14. Claims 21-22, 24-26, 28-29 and 31 are rejected under 35 U.S.C. 103(a) as being anticipated by Sheridan [U.S. Pat. No. 5760917].

15. As to claims 21, 25 and 29, Sheridan teaches a server/method/terminal to distribute information, comprising: a communication unit [e.g., Hub station 20, Fig.6] receiving a request including access destination information from a terminal [e.g., 40A, Fig.6] and distributing information to a plurality of terminals; and a processor controlling the communication unit to access to a content server [e.g., Hub station 21, Fig.6] and obtain the information by using the access destination information upon receiving of the request and controlling the communication unit to distribute the information obtained from the content server to the plurality of terminals [col.13, lines 13-42].

16. As claims 22 and 26, Sheridan teaches that the method further comprising storing the information in a storing unit and deleting the stored information after completion of the information distribution [e.g., col.3, lines 8-15; note that the “information” here is related to the access rights].

17. As to claims 24, 28 and 31, Sheridan further teaches that the access information identifies the content server and indicates data location in the content server [e.g., col.13, lines 28-41; it is further noted that a provider’s content database is typically organized with keys that specific content can be retrieved by specifying the name of a content which a user provides in the request].

***Claim Rejections - 35 USC § 103***

18. Claims 6, 9-15, 18 and 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan [U.S. Pat. No. 5760917].

19. Sheridan was cited in the previous office action.

20. As to claim 1, Sheridan teaches the invention as claimed including: an information distribution device [20, Fig.3] which is connected with a plurality of terminal devices [e.g., 40A – 40N, Fig.3] which belong to a group, and a content server storing distribution information via a network [e.g., 2A – 2N of Fig. 3 are content servers] using an IP protocol, said information distribution device, comprising:

a first storage portion storing terminal information including addresses each identifying a terminal device belonging to said group, on the network using IP protocol [Figs. 1-2, col.4, lines 17-33, wherein a user may designated a group of (third party) terminal devices to whom the photographs would be shared; note that each email address is associated with an email provider's IP address];

a first receiving portion receiving, from one terminal device belonging to said group [e.g., 202, Fig.1], a distribution request including a Uniform Resource Location as access information [e.g., col. 5, lines 23-27] and distribution destination information, said access information being required for accessing the distribution information stored in the content server, said distribution destination information specifying addresses on the network of other terminal devices that the one terminal device which belong to said group and to which the distribution information is to be distributed [col.4, lines 48-67; col.5, lines 7-18];

a second receiving portion accessing said distribution information stored in a content server [e.g., any of 2A-2N, Fig.3], based on said access information included in the distribution request received by said first receiving portion from the one terminal device, and for receiving the distribution information accessed [col.5, lines 31-42; note that the low-resolution images are derived from high resolution images originated in the scanner stations];

a second storage portion storing said distribution information accessed and received by said second receiving portion [i.e., the low-resolution images are transmitted from the processing centers (2A-2N, Fig.3) to the central image server (20, Fig.3) and stored therein for subsequent distribution]; and

a first transmitting portion transmitting said distribution information stored in said second storage portion to the other terminal devices [col.5, lines 31-64; e.g., the distribution server pushes low resolution photographs to the mailboxes belonging to the terminals of the group) via each service provider's IP address, allowing each terminal device to download the images therefrom].

Sheridan does not specifically teach having a third receiving portion receiving a bill of charges from a device billing charges for the distribution information when the distribution information is chargeable; and a second transmitting portion transmitting said bill of charges received by said third receiving portion either to the one terminal device having transmitted the distribution request or to a telecommunications carrier to which the one terminal device subscribes.

However, as in photo processing service, it is clear that user who submitted original films to Sheridan's distributed processor scanner (2A-2N, Fig. 3) must be charged for the original processing cost and optionally for distribution fee. As such, it would have been obvious to one of ordinary skill in the art to have used Sheridan's distributed processor scanner to issue a bill the central image server (20, Fig.3), which contains the user's information and other subsequent image printing activities and relay appropriate billing charges to the user (who submitted the original films) because Sheridan's central image server is the center of user contact through which it may facilitate the billing process.

21. As to claim 5, Sheridan further teaches transmitting notification, to the terminal device which transmitted said distribution request, of the fact that distribution has been completed, after the distribution of said distribution information by said first transmitting portion [col.6, lines 13-24].

22. As to claim 6, Sheridan further teaches that said distribution request further includes additional information added to said distribution information, and said first transmitting portion distributes said additional information in addition to said distribution information [col.5, lines 19-42].

23. As to claim 9, Sheridan further teaches that said first receiving portion receives said distribution request from said terminal device via another server device [note that Sheridan's system is inherently able to receive terminal device transmitted via an ISP server because Sheridan's system is tied to the Internet (205, Fig.1)].

24. As to claim 10, Sheridan further teaches that said distribution information is either a program including a game program, said program and a license for said program, map information, or product information [note that photograph is a product information].

25. As to claims 11-12, 14-15 and 18, since the features of these claims can also be found in claims 1, 6 and 10, they are rejected for the same reasons set forth in the rejection of claims 1, 6 and 10 above.

26. Claims 7-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan [U.S. Pat. No. 5760917], as applied to claims 1-6, 9-12 and 14-20 above, further in view of Official Notice.

27. As to claim 7, Sheridan does not specifically teach that said distribution request further includes a distribution time for specifying a time for distributing said distribution information, and said first transmitting portion distributes said distribution information at said distribution time.

However, Official Notice is taken that distributing information according to planned schedule is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users of Sheridan's system to specify timing constraint or delivery time as an option because such feature serves good customer service, in particular when distribution of certain photos is time-sensitive.

28. As to claim 8, Sheridan further teaches that said terminal device information stored in said first storage portion includes information for representing an information format displayable on a display portion of the terminal device [220, Fig.2].

Sheridan does not specifically teach that said information distribution device further comprises a conversion/filtering portion for converting or filtering said distribution information to a format capable of being displayed on a display portion of said terminal device, based on said information for representing said displayable information format.

However, Official Notice is taken that establishing device profile regarding capabilities of the various clients' devices for transmitting information in a displayable format is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to consider a terminal device's display capability and make appropriate format conversion in Sheridan's system prior transmission because by doing so it would enable individuals holding different types of devices to receive appropriate information (in terms of content and format).

29. As to claim 13, since the features of this claim can also be found in claims 1, 7 and 11, it is rejected for the same reasons set forth in the rejection of claims 1, 7 and 11 above.

30. Applicant's arguments filed on 1/22/08 for claims 1, 5-15 and 18 have been fully considered but are moot in view of the new grounds of rejection.

Additionally, Applicant challenges the use of Official Notice. Applicant is reminded that the rejection of claims 7-8 and 13 using Official Notice have been cited for over four previous office actions. In the final rejection filed 5/2/2005 (wherein claims 8 and 13 were rejected citing Official Notice and claim 7 was rejected citing Kamensky) a statement was explicitly made at page 10, paragraph 22 that "[b]ecause Applicants have failed to challenge any of the Examiner's Official Notices stated in the previous office actions in a proper and reasonably manner before, they had been considered as admitted prior art. See MPEP 2144.03." For at least the foregoing reason, Applicant's challenge

on the rejection of claims 8 and 13 is moot and an evidentiary document supporting the rejection of claim 7 is hereby directed to Kamentsky (see paragraph 42).

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully

consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquiries draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

April 26, 2008

/Wen-Tai Lin/

Primary Examiner, Art Unit 2154

